

REMARKS

Claims 1-36 are pending in the application. Claims 26, 27 and 30-36 have been withdrawn from consideration by the Examiner as being directed to a non-elected invention. Claims 1-25, 28 and 29 have been rejected.

Additionally, entry and consideration of the following remarks is respectfully requested.

I. The 37 C.F.R. §1.142 (b) Restriction:

Claims 26, 27 and 30-36 have been withdrawn from consideration by the Examiner as being directed to a non-elected invention. The Examiner contends that claims 26, 27 and 30-36 are directed to a species which is distinct from the invention originally claimed. Applicant acknowledges and thanks the Examiner for withdrawing the restriction requirement as to Claims 25, 28 and 29 as shown in the listing of claims on page 2 of this paper.

The requirement for election is respectfully traversed because new claims to two distinct species have not been presented here. Claims 26, 27 and 30-36 are not directed to an invention distinct from and independent of the invention previously claimed. Claims 26, 27 and 30-36 act to further limit the plasticizer (B) of claim 1 by reciting specific examples. For example, claims 27 and 31 require that the plasticizer (B) is a terpolymer of (a) an olefin, (b) a comonomer selected from acrylic acids or esters, methacrylic acids and esters, and vinyl acetates, and (c) carbon monoxide. Support for claims 26, 27 and 30-36 can be found in the specification. Therefore, Applicants respectfully traverse Examiner's withdrawal of claims 26, 27 and 30-36, and request reinstatement and allowance of claims 26, 27 and 30-36.

II. The 35 U.S.C. §112, Second Paragraph Rejection:

Claims 1-9 and 25 have been rejected under 35 U.S.C. §112, second paragraph, as indefinite. Specifically, the Examiner contends that the phrase "a major amount" is vague and indefinite, and it is not clear as to the scope of the limitation as used in the claims.

Applicants submit that this term is not indefinite, but is a well recognized and often used term within the patented art. The term "a major amount" should be considered definite because those skilled in the art would be able to determine from the written disclosure, including the examples, what a major amount is. A person of ordinary skill in the art upon reading Applicants' specification would be able to determine that the term "a major amount" means greater than 50%.

Applicants submit that the U.S. Patent and Trademark Office has recognized "a major amount" as a definite term. The term "a major amount" has been used extensively in patent claims. Over a thousand U.S. patents have issued with the term "a major amount". For example, U.S. Patent Nos. 6,656,739 and 6,660,695 both utilize the term "a major amount" in the claims and do not specifically define the term in the specification.

In view of the above, Applicants believe the rejection of claims 1-9 and 25 to be unfounded. Accordingly, withdrawal of the rejection of claims 1-9 and 25 is believed due and is respectfully requested.

III. The Art Rejections:

A. Claims 1-14, 25, 28 and 29 have been rejected under 35 USC §102(b) or, in the alternative, under 35 U.S.C. §103(a) over Kushida et al. (US Patent No. 5,344,864).

Kushida teaches a polyvinyl chloride thermoplastic elastomer composition employed as a substitute for vulcanized rubber. Kushida does not disclose the use of its composition in a film. In the background, Kushida states that vinyl chloride resins incorporated with a plasticizer are used for many applications such as films, sheets, tubes or containers. This general statement is then followed by a discussion of the problems associated with the addition of a plasticizer, such as strong creep tendency and large compression set. (Col. 1, lines 25-45). This statement is describing the PVC resin Kushida uses in making the vulcanized rubber substitute, and the uses of the PVC resin. Kushida is not describing the uses of its polyvinyl chloride thermoplastic elastomer composition, nor does Kushida disclose the use of its composition in a film.

In the final rejection, the Examiner maintains that Kushida 's composition "is directed to various applications for which conventional rubber is employed, such as packings, gaskets, sheets... As such, it would have been obvious to one of ordinary skill in the art to prepare a film from Kushida's composition, as films and 'packings...sheets' are clearly analogous art of the same field." (Examiner's Action, page 5, first paragraph).

When describing the prior uses of vinyl chloride resin, Kushida distinguishes between a film and a sheet at Column 1, lines 30-31 when he states "...it is used in many applications as resin material for various molded products such as films, sheets, tubes or containers." In contrast, in Kushida's description of the various applications of its thermoplastic composition, Kushida only specifies: "...sheets, hoses, tubes, rolls..." (Col. 7, lines 1-12). Since Kushida distinguished between films and sheets in its background, it only makes sense that if Kushida intended to prepare a film from its composition, it would have also listed films in its description of applications. Accordingly, for these reasons claims 1-14, 25, 28 and 29 are not obvious over Kushida et al.

Additionally, Kushida does not disclose a film having an elongation greater than 50% or a thickness from about 1 to about 20 mils. As stated above, Kushida does not teach or suggest preparing a vinyl halide film from their polyvinyl chloride thermoplastic elastomer compositions. Since Kushida does not disclose the use of its composition in a film, it also does not disclose an elongation or a thickness for the film. The elongation or thickness disclosed in the present application would also not be known by one of ordinary skill in the art after reading Kushida's disclosure. Accordingly, for these additional reasons claims 1-14, 25, 28 and 29 are not obvious over Kushida et al.

Further, Kushida does not disclose a liquid plasticizer as recited in claims 25, 28 and 29. The Examiner contends that NBR is present in non-crosslinked form as a flowable material. However, NBR is not present in the composition as a plasticizer. (Col. 2, lines 31-37). NBR is present in the composition in addition to a plasticizer. The plasticizers disclosed by Kushida are not described as being in liquid form, see Col. 4, lines 37-46. Accordingly, for these reasons claims 25, 28 and 29 are not obvious over Kushida et al.

Therefore, Applicants submit that claims 1-14, 25, 28 and 29 are novel and not obvious over Kushida et al. Accordingly, withdrawal of the rejection of claims 1-14, 25, 28 and 29 is believed due and is respectfully requested.

B. Claims 22-24 have been rejected under 35 U.S.C. §102(a) over Breton et al. (U.S. Patent No. 6,054,524).

Breton teaches that the plastisol compositions containing aliphatic solvents can be made utilizing a combination of a primary and/or secondary plasticizer, wherein primary aromatic plasticizers are normally preferred. (Col. 2, lines 1-7). Consequently, the plastisol composition of Breton includes an aliphatic solvent and may also include an aromatic plasticizer. Applicants' claimed invention requires an aromatic solvent, not an aliphatic solvent. Applicants' claim 22 is directed to a plastisol composition which contains (A) a vinyl halide polymer, (B) a non-halogenated polymeric plasticizer, (C) a second plasticizer, and (D) an aromatic solvent. The use of an aromatic solvent would not have the same viscosity decreasing effect as the use of an aliphatic solvent on the plastisol composition. Thus, one of ordinary skill in the art would not be motivated to substitute the aliphatic solvent of Breton with an aromatic solvent, such that Breton would include an aromatic solvent and an aromatic plasticizer.

Therefore, Applicants submit that claims 22-24 are novel over Breton et al. Accordingly, withdrawal of the rejection of claims 22-24 is believed due and is respectfully requested.

C. Claims 15-21 have been rejected under 35 U.S.C. §103(a) over Kushida et al. (U.S. Patent No. 5,344,864).

As described above, Kushida does not teach or suggest the use of its thermoplastic elastomer composition in a film. In contrast, Kushida teaches a thermoplastic elastomer composition which is useful as a substitute for vulcanized rubber. Thus, even if forming an adhesive tape based on a plasticized polyvinyl chloride substance is old and well known, one of ordinary skill in the art would not be motivated to use the composition of Kushida to make a film, much less a film containing

an adhesive layer. Furthermore, there is no reasonable expectation of success for the use of the Kushida composition to make a film and use it in an adhesive article.

Accordingly, Applicants submit that claims 15-21 are not rendered obvious by the combination of Kushida. Accordingly, withdrawal of the rejection of claims 15-21 is believed due and is respectfully requested.


CONCLUSION

In view of the foregoing remarks, Applicants respectfully request allowance of claims 1-36.

Should the Examiner believe that a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

In the event any fees are due in connection with the filing of this document, the Commissioner is authorized to charge those fees to our Deposit Account No. 18-0988 under Attorney Docket No. **AVERP2997USA**.

Respectfully submitted,
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